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In re Application of CHENG et al. :
Application No.: 10/551,663 : DECISION ON PETITION
PCT No.: PCT/US04/10222 :
Int. Filing: 02 April 2004 : UNDER 37 CFR 1.47(a)
Priority Date: 02 April 2003 :
Attorney Docket No.: 102907-438-NP :
For: ADAPTIVE ENGINE LOGIC USED IN :
TRAINING ACADEMIC PROFICIENCY :

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 16 August 2006, to accept the application without the signature of joint inventor, Joshua Levine.

BACKGROUND

On 30 September 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 26 May 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 16 August 2006, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Joshua Levine alleging that Mr. Levine refuses to sign the application.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application

or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor Joshua Levine was provided. With regard to item (4), the declaration executed by the available joint inventors on their behalf and on behalf of the non-signing inventor was submitted and satisfies the requirements of 37 CFR 1.47(a).

With respect to Item (2) above, Petitioner provided the declaration of Robert P. Udal in support of the petition under 37 CFR 1.47(a). According to Dr. Udal, a review of the law firm's application file reveals that Patrice King, a former Goodwin Procter attorney, sent a copy of the declaration of inventorship, patent assignment and PCT publication to Mr. Levine via email dated 13 April 2005 and via Federal Express. Further, Mr. Levine was instructed to return a copy of the executed documents to Goodwin Procter via email or facsimile and by mail. Reminder letters were sent on 18 May 2005 and 19 September 2005 via email to Mr. Levine. Similar reminder letters were sent via Federal Express. Mr. Levine did not respond to these communications. Dr. Udal concludes that Mr. Levine refuses to sign the declaration. Copies of the email correspondence accompanied the petition.

A statement of first hand knowledge from Patrice King regarding the details of her attempts to contact Mr. Levine was not provided. No explanation as to the lack of first hand statement is given, other than Ms. King was formerly an attorney at the firm. This raises the questions as to whether she is unavailable or unwilling to make such statement. Also it appears from the letters sent to Mr. Levine that a "Declaration of Inventorship" and a "Patent Assignment" were attached but no mention is made in the letter that a copy of the application papers (specification, claims and drawings) were presented. Thus, without the first hand statement of the person who prepared and sent the email/letter, it is not clear that a complete copy of the application papers, including *specification, claims and drawings* and declaration, were provided to Mr. Levine. What is required is that Mr. Levine be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application.

Furthermore, there is no evidence that the emails and letters were delivered to Mr. Levine. Petitioner has not produced a Federal Express delivery statement or an email delivery confirmation. Proof that a bona fide attempt was made to present a copy of the application papers to the nonsigning inventor for signature should be provided. The circumstances of the presentation of the application papers and the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and to whom the refusal was made.

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or , if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956)

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a *copy of the application papers for U.S. application 10/551,663 (specification, including claims, drawings, and declaration)* to the nonsigning inventor for his signature and (2) Mr. Levine's refusal to sign,

either in writing or by telephone, these documents.

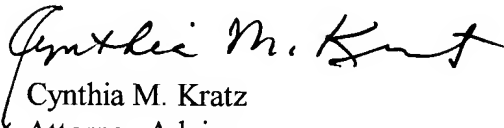
For the reasons set forth above, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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